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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,393	09/23/2003	Jon Godston	010398-9065-02	2524

7590 08/25/2005

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Milwaukee, WI 53202-4108

EXAMINER
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ALIE, GHASSEM

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/668,393	<b>Applicant(s)</b> GODSTON ET AL.	
	<b>Examiner</b> Ghassem Alie	<b>Art Unit</b> 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 May 2005.  
 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 and 14-39 is/are pending in the application.  
     4a) Of the above claim(s) 1-7 and 22-39 is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 14-21 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☒ The drawing(s) filed on 23 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Election/Restrictions***

1. Applicant's election with traverse of Group III (claims 14-21) and Species E (Figs. 11-14) on 01/31/05 and 05/19/05 acknowledged. The traversal is on the ground(s) that that Groups I and III-V are not independent or distinct and that examination of the claims of Groups I and III-V can be made without serious additional burden on the Examiner. Firstly, each of individual Groups I and III-V has distinct features and is a distinct invention, as discussed and explained on restriction requirement mailed on 12/27/04. Each individual invention with distinct features has a separate status in the art and naturally requires a different field of search. It should be noted, "for purpose of the initial requirement a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of each as defined in MPEP § 808.2." See MPEP § 803. As stated above, the Examiner has shown that each individual distinct invention of Groups I and III-V has a separate status in the art and a different field of search. Therefore, there is a serious burden on the Examiner to examine all distinct individual inventions of Groups I and III-V together. Secondly, applicant's argument that all independent claims are Group I and III-V claim the same invention but are of varying scope is not persuasive. As stated clearly on the restriction requirement mailed on 12/27/04, the distinct limitations and features of each independent claim in Groups I and III-V have a separate status in the art and naturally requires a different field of search.

The traversal also is on the ground(s) that the Species B, D, and F seem to fall within the scope of Species A, C, and E. There are different Species in the instant application as set

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forth in restriction requirement mailed on 12/27/04. Figs. 1-9, Fig. 10, and Figs. 11-14 show three different Species. Furthermore, claims 19 and 20 also are directed toward two different Species that are related to the upright angle of the workpiece. Claim 19 sets forth less than 45 degrees angle for the upright angle of the workpiece and claim 20 sets forth less than 25 degrees angle for the upright angle of the workpiece. However, because an angle less than 25 degrees is obvious variant of an angle less than 45 degrees, claims 19 and 20 will be rejoined and examine with the elected Species E (Figs. 11-14). Therefore, Species F and E are rejoined and will be examined. Applicant's argument that the examination of Species A-E also would not be no serious additional burden on the Examiner is not persuasive. The search for each species is not identical. The Search for each species may overlap but they do not coincide identically throughout. Therefore, there is serious burden on the Examiner to examine all Species A-E. Nevertheless, if applicant provides a statement that the Species are obvious variant of each other (See the election requirement), the restriction requirement with respect to the Species will be withdrawn. Burden is not the issue in the Species requirement. However, there is a burden when there is multiple searches involved in multiple inventions and the Examiner is in time constrain.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1-7 and 22-39 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions, there being no allowable generic or linking claim.

*Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 14-17 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Groswith, III et al. (5,163,350), hereinafter Groswith. Regarding claim 14, Groswith teaches a punch 12 for punching a workpiece including a four bar linkage 32 having at least four members 33-36. Groswith also teaches that at least one punch 35, 50, 85 operably associated with a first member 33 of the linkage wherein, upon actuation of the linkage, an arcuate motion of the first member of the linkage drives the punch 35, 50, 85 element to punch a hole in the workpiece. See Figs. 1-23 and col. 5, lines 16-668 and col. 6, lines 1-68 and col. 11, lines 1-32 in Groswith.

Regarding claim 15, Groswith teaches everything noted above including that upon actuation of the linkage 32, the first member 33 of the linkage abuts the at least one punch element 50, 85. See Figs. 7-23.

Regarding claim 16, Groswith teaches everything noted above including a second member of the linkage is configured to support the remaining member of the linkage and the at least one punch element 35, 50, 85. It should be noted that any of member of the linkage 33-36 can be considered as a second member that supports the remaining members and the punch 35, 50, 85 by a punch plate that is connected to the linkage 32.

Regarding claims 17 and 21, Groswith teaches everything noted above including that the first member 33 if the linkage 32 operates the at least one punch element 50, 85 by

imparting a camming action upon the at least one punch element. Groswith also teaches that the linkage 32 is actuated upon a motion of a third member of the linkage and the first and third members are pivotally associated.

*Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all Obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patent ability shall not be negative by the manner in which the invention was made.

6. Claims 14-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otsuka et al. (3,921,487), hereinafter Otsuka in view of Groswith. Regarding claim 14, Otsuka teaches a punch for punching at least one sheet of paper including a support portion 8, 12, 16 which includes an arcuate portion. The perforated plate, the guide member 12, and the guide pieces 16 define the support portion. The upper section of the guide member 12 includes an arcuate portion. Otsuka also teaches at least a punch mechanism 7, 24 operably associated with the support portion 8, 12, and 16 to punch the sheet of paper upon actuation of the punch 7. See Figs. 1-4 in Otsuka. Otsuka does not teach a four bar linkage as an actuating device which includes at least four members. Otsuka also does not teach that at least one punch element operably associated with a first member of the linkage wherein, upon actuation of the linkage, an arcuate motion of the first member of the linkage drives the punch element to punch a hole in the workpiece. However, the use of a four bar linkage for actuating at least a punch is well known in the art such as taught by Groswith. Groswith teaches a punch 12 for punching a workpiece including a four bar linkage 32 having at least

four members 33-36. Groswith also teaches that at least one punch 35, 50, 85 operably associated with a first member 33 of the linkage wherein, upon actuation of the linkage, an arcuate motion of the first member of the linkage drives the punch 35, 50, 85 element to punch a hole in the workpiece. See Figs. 1-23 and col. 5, lines 16-668 and col. 6, lines 1-68 and col. 11, lines 1-32 in Groswith. It would have been obvious to a person of ordinary skill in the art to replace Otsuka's punch actuating mechanism with the four bar linkage as taught by Groswith, since Otsuka's punch actuating mechanism functionally is equivalent to Groswith's four bar linkage. In addition, it would have been obvious to a person of ordinary skill in the art to replace Otsuka's punch actuating mechanism with the four bar linkage as taught by Groswith, since the four bar linkage reduces the force needed to actuate a punch.

Regarding claim 15, Otsuka, as modified by Groswith, teaches everything noted above including that upon actuation of the linkage 32, the first member 33 of the linkage abuts the at least one punch element 50, 85. See Figs. 7-23 in Groswith.

Regarding claim 16, Otsuka, as modified by Groswith, teaches everything noted above including a second member of the linkage is configured to support the remaining member of the linkage and the at least one punch element 35, 50, 85. It should be noted that any of member of the linkage 33-36 can be considered as a second member that supports the remaining members and the punch 35, 50, 85 by a punch plate that is connected to the linkage 32. See Figs. 7-23 in Groswith.

Regarding claims 17 and 21, Otsuka, as modified by Groswith, teaches everything noted above including that the first member 33 of the linkage 32 operates the at least one punch element 50, 85 by imparting a camming action upon the at least one punch element.

Growth also teaches that the linkage 32 is actuated upon a motion of a third member of the linkage and the first and third members are pivotally associated. See Figs. 7-23 in Growth.

Regarding claim 18, Otsuka, as modified by Growth, teaches everything noted above including that one of the at least four members includes a support member 16 to accommodate and locate the workpiece in an upward punching position. See Fig. 1 in Otsuka and Figs. 7-23 in Growth.

Regarding claims 19 and 20, Otsuka teaches everything noted above including that the support member 16 is oriented at an angle from a vertical. It appears that the angle of the support member 16 with respect to a vertical is 45 degrees from the vertical line. See Fig. 2 in Otsuka. Otsuka in view of Growth does not expressly teach that the angle is less than 40 degrees or less than 25 degrees. However, it would have been to orient the support member at an angle from a vertical, which is less than 45 degrees or 25 degrees, since the specific angle of the support member with respect to a vertical, is not critical to the function of the support member and it is a matter of a design choice to provide the support member with a specific angle with respect to a vertical. In addition, applicant does not teach that less than 45 degrees or less than 25 degrees angle of the support member with respect to a vertical is critical to the instant invention. Furthermore, the use of support members that are oriented upright to an angle less than 25 degrees or less than 45 degrees to a vertical is well known in the art such as taught by Scharer (4, 645,399), Hu (5,575,188), or Becker (2,421,864). Becker's support portion is even adjustable relative to the vertical line which is perpendicular to the base of a punching device.



*Conclusion*

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Giulie (4,706,533), Chiang (5,044,242), Baumann (5,431,519), Miner (1,054,132), Watkins et al. (5,740,712), Randall (4,664,004), Gibson (5,377,415), Dewey (3,821,890), Terracciano (4,611,520), Shaughnessy (4,173,162), Hafner (4,184,396), and Borzym (4,301,723) teach a punch having a four bar linkage.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ghassem Alie whose telephone number is (571) 272-4501. The examiner can normally be reached on Mon-Fri 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on (571) 272-4514. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, SEE <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (too-free).

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GA/ga

August 18, 2005

  
**Allan N. Shoap**  
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